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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/027,928 | 12/21/2001 | Monica A. McClintic | 5013US (01-01-054) | 9875 |

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| EXAMINER | |
|---|---|
| COBURN, CORBETT B | |
| ART UNIT | PAPER NUMBER |
| 3714 | |

DATE MAILED: 03/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/027,928 | MCCLINTIC ET AL. | |
| | Examiner | Art Unit | |
| | Corbett B. Coburn | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-85* is/are pending in the application.

4a) Of the above claim(s) *39-85* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4,5,9*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-38 in Paper No. 10 is acknowledged.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

3. The drawings are objected to because of the issues noted in the attached Notice of Draftsperson's Patent Drawing Review. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. In Figure 6, Boxes 118, 120 & 122 should contain explanatory text.

### *Specification*

5. The abstract of the disclosure is objected to because it contains language that can be inferred. For instance, it describes, "A new and improved gaming method..." Should a patent issue, the gaming method would, by definition, be "new and improved". Also, references to the apparatus should be deleted as only the method is claimed. Correction is required. See MPEP § 608.01(b).

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method Of Playing A Matching Bonus Game.

***Claim Objections***

7. Claim 11 is objected to because of the following informalities: The claim appears to be missing "spaces". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Colin et al. (US Patent Number 6,346,043).

**Claim 1:** Colin teaches providing a base game and qualifying for a bonus game. (Col 2, 38-44) The bonus game has an array of game spaces, each having an associated hidden indicium that matches with at least one other hidden indicium associated with another game space. (Fig 2) In bonus game play, the player selects a first game space from the array of game spaces. This reveals the hidden indicium associated with the first game space. The player then selects a second game space from the array of game spaces, revealing the hidden indicium associated with the second game space. The game then determines if the revealed indicium associated with the first game space matches the revealed indicium associated with the second game space and makes an award if the

revealed indicia are determined to match. (Fig 1) After the bonus game, the player may return to the base game.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 2-11 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colin et al. (US Patent Number 6,346,043) as applied to claim 1 in view of Mirando (US Patent Number 5,511,271).

**Claim 2:** Colin teaches the invention substantially as claimed but does not teach repeating the selection of game spaces a predetermined number of times. Mirando teaches repeating the selection of game spaces a predetermined number of times. Limiting the number of attempts to obtain a match speeds the game. It is well known that speed of play is a significant factor in game profitability. Mirando recognizes this fact and provides both a limit on the number of choices and a timer. (Col 2, 14-16) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin in view of Mirando to repeat the selection of game spaces a predetermined number of times in order to speed up play of the game, thus increasing casino profitability.

**Claims 3, 8:** Colin teaches the invention substantially as claimed, but does not teach revealing for a predetermined period of time the hidden indicium associated with each

game space. Mirando teaches revealing for a predetermined period of time the hidden indicium associated with each game space. (Col 2, 1-3) This makes the game not only entertaining, but also educational. (Col 2, 23-25) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin in view of Mirando to reveal for a predetermined period of time the hidden indicium associated with each game space in order to make the game not only entertaining, but also educational.

**Claims 4, 9:** Mirando teaches that revealing for a predetermined period of time the hidden indicium associated with each said game space is responsive to a player satisfying at least one predetermined requirement – i.e., beginning the game is the predetermined requirement.

**Claims 5, 6, 10, 11, 19:** Mirando teaches randomly reassociating indicia with game spaces at the end of each game. (Col 2, 19-22)

**Claim 7:** Colin teaches collecting matches made by a player into a combination of matches, evaluating the combination, and awarding a payout based on a predetermined value assigned to the combination. (Fig 1)

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colin as applied to claim 1 above, and further in view of Baerlocher et al. (US Patent Number 6,669,559).

**Claim 12:** Colin teaches the invention substantially as claimed, but fails to teach repeating the selections until a special game end indicium is revealed. Baerlocher teaches repeating the selections until a special game end indicium is revealed. Ending the game when a special game end indicium appears adds to the excitement of the game because each symbol selected potentially ends the game. It would have been obvious to one of

ordinary skill in the art at the time of the invention to have modified Colin in view of Baerlocher to repeat the selections until a special game end indicium is revealed in order to add excitement to the game.

13. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colin and Baerlocher as applied to claim 12 above, and further in view of Mirando.

**Claim 13:** Colin and Baerlocher teach the invention substantially as claimed, but fail to teach revealing for a predetermined period of time the hidden indicium associated with each game space. Mirando teaches revealing for a predetermined period of time the hidden indicium associated with each game space. (Col 2, 1-3) This makes the game not only entertaining, but also educational. (Col 2, 23-25) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin and Baerlocher in view of Mirando to reveal for a predetermined period of time the hidden indicium associated with each game space in order to make the game not only entertaining, but also educational.

**Claims 14, 17:** Mirando teaches that revealing for a predetermined period of time the hidden indicium associated with each said game space is responsive to a player satisfying at least one predetermined requirement – i.e., beginning the game is the predetermined requirement.

**Claims 15, 16, 18:** Mirando teaches randomly reassociating indicia with game spaces at the end of each game. (Col 2, 19-22)

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colin as applied to claim 1 above, and further in view of Bennett (US Patent Number 6,572,471).

**Claim 20:** Colin teaches the invention substantially as claimed. Colin teaches a Joker that serves as a wild card in that it is combined with the other cards that match to determine the bonus award. (Col 3, 20-25) This wild card does not, however, complete the match. Bennett teaches determining if one of the two revealed indicia is a wild indicium, resulting in an automatic match. (Fig 9 & Col 5, 53-5) Wild cards are extremely well known to the art. They are known to add excitement to the game by increasing the player's chances of winning, thus attracting players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin in view of Bennett to determine if one of the two revealed indicia is a wild indicium, resulting in an automatic match in order to add excitement to the game by increasing the player's chances of winning, thus attracting players.

15. Claims 21-30 & 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colin & Bennett as applied to claim 20 above, and further in view of Mirando.

**Claim 21:** Colin & Bennett teach the invention substantially as claimed but do not teach repeating the selection of game spaces a predetermined number of times. Mirando teaches repeating the selection of game spaces a predetermined number of times. Limiting the number of attempts to obtain a match speeds the game. It is well known that speed of play is a significant factor in game profitability. Mirando recognizes this fact and provides both a limit on the number of choices and a timer. (Col 2, 14-16) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin and Bennett in view of Mirando to repeat the selection of game spaces a

predetermined number of times in order to speed up play of the game, thus increasing casino profitability.

**Claims 22, 27:** Colin & Bennett teach the invention substantially as claimed, but do not teach revealing for a predetermined period of time the hidden indicium associated with each game space. Mirando teaches revealing for a predetermined period of time the hidden indicium associated with each game space. (Col 2, 1-3) This makes the game not only entertaining, but also educational. (Col 2, 23-25) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin and Bennett in view of Mirando to reveal for a predetermined period of time the hidden indicium associated with each game space in order to make the game not only entertaining, but also educational.

**Claim 23, 28, 36:** Mirando teaches that revealing for a predetermined period of time the hidden indicium associated with each said game space is responsive to a player satisfying at least one predetermined requirement – i.e., beginning the game is the predetermined requirement.

**Claims 24, 25, 29, 30, 37 & 38:** Mirando teaches randomly reassociating indicia with game spaces at the end of each game. (Col 2, 19-22)

**Claim 26:** Colin teaches collecting matches made by a player into a combination of matches, evaluating the combination, and awarding a payout based on a predetermined value assigned to the combination. (Fig 1)

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colin and Bennett as applied to claim 20 above, and further in view of Baerlocher et al. (US Patent Number 6,669,559).

**Claim 31:** Colin and Bennett teach the invention substantially as claimed, but fail to teach repeating the selections until a special game end indicium is revealed. Baerlocher teaches repeating the selections until a special game end indicium is revealed. Ending the game when a special game end indicium appears adds to the excitement of the game because each symbol selected potentially ends the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin and Bennett in view of Baerlocher to repeat the selections until a special game end indicium is revealed in order to add excitement to the game.

17. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colin, Bennett, and Baerlocher as applied to claim 31 above, and further in view of Mirando.

**Claims 32:** Colin & Bennett teach the invention substantially as claimed, but do not teach revealing for a predetermined period of time the hidden indicium associated with each game space. Mirando teaches revealing for a predetermined period of time the hidden indicium associated with each game space. (Col 2, 1-3) This makes the game not only entertaining, but also educational. (Col 2, 23-25) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Colin and Bennett in view of Mirando to reveal for a predetermined period of time the hidden indicium associated with each game space in order to make the game not only entertaining, but also educational.

**Claim 33:** Mirando teaches that revealing for a predetermined period of time the hidden indicium associated with each said game space is responsive to a player satisfying at least one predetermined requirement – i.e., beginning the game is the predetermined requirement.

**Claims 34, 35:** Mirando teaches randomly reassociating indicia with game spaces at the end of each game. (Col 2, 19-22)

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| Reference Name | US Patent Number | Applicability |
|---|---|---|
| Walker et al. | 6,174,235 | Matching game reveals indicia if player satisfies condition |
| Bennett | 6,015,346 | Matching game |
| Bennett | 6,261,177 | Matching game |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER